

REMARKS/ARGUMENTS

In the Office Action mailed February 27, 2009, claims 1-20 were rejected. In response, Applicant hereby requests reconsideration of the application in view of the proposed amendments and the below-provided remarks. No claims are added. Applicant submits that the proposed amendments place the present application in condition for allowance or in better condition for appeal.

For reference, proposed amendments are submitted for claims 1, 10, and 16. In particular, the proposed amendments for claim 1 are presented to recite language related to the subject matter previously recited in claims 15 and 17. Consequently claims 15 and 17 are canceled, and the proposed amendment for claim 16 is presented to depend from claim 1 rather than canceled claim 15. The proposed amendments presented for claim 10 are similar to the proposed amendments presented for claim 1. These proposed amendments are supported, for example, by the subject matter described in the specification at page 6, lines 7-11, and at page 7, lines 31-34, of the present application.

Withdrawal of Finality

As a preliminary matter, Applicant respectfully notes that the finality of the present Office Action is premature because the Office Action does not establish a *prima facie* rejection for each of the claims. In particular, the Office Action does not establish a *prima facie* rejection for claim 17 (the subject matter previously recited in claim 17 is now recited in claims 1 and 10) because the Office Action does not address the actual language of the claim, as described below. Therefore, since the Office Action does not establish proper rejections for the subject matter recited in each of the claims, Applicant submits that the finality of the present Office Action is premature. Accordingly, Applicant respectfully requests that the finality of the present Office Action be withdrawn because the finality of the present Office Action is premature.

Claim Rejections under 35 U.S.C. 102 and 103

Claims 1-3, 6, 8-10, and 20 were rejected under 35 U.S.C. 102(c) as being anticipated by Laackmann et al. (U.S. Pat. Pub. No. 2003/0132777, hereinafter

Laackmann). Additionally, claims 4 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Laackmann in view of Benkley (U.S. Pat. Pub. No. 2003/0035570, hereinafter Benkley). Additionally, claims 5, 7, 13, and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Laackmann in view of Rayane et al. (“A Digital BIST for Operational Amplifiers Embedded in Mixed-Signal Circuits” Proceedings of IEEE VLSI Test Symposium; 1999, pp. 304-310, hereinafter Rayane). Additionally, claims 11 and 15-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Laackmann in view of Yamashita (U.S. Pat. No. 6,467,083, hereinafter Yamashita). Additionally, claims 14 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Laackmann in view of Benkley and in view of Rayane. However, Applicant respectfully submits that these claims are patentable over Laackmann, Benkley, Rayane, and Yamashita for the reasons provided below.

Independent Claim 1

Claim 1 recites “a monitoring circuit arranged to monitor a deviation in the capacitance of the connection means and to generate an alert signal if the deviation exceeds a predetermined value, wherein the monitoring circuit is further configured to generate a plurality of alert signals, including up to one alert signal for each address bit line and data bit line that is monitored, wherein the monitoring circuit further comprises logic gates to combine the plurality of alert signals into a single alert signal and to output the single alert signal” (emphasis added).

It should be noted, for clarity, that the subject matter emphasized above was previously presented in claim 17, but is now included in claim 1 by way of the proposed amendments presented herein. Thus, some of Applicant’s remarks herein are directed to the language and analysis of the rejection of claim 17, as set forth in the present Office Action. Nevertheless, such remarks are applicable to the patentability of claim 1, as presented, because the proposed amendments for claim 1 include the language and subject matter previously recited in claim 17.

The rejection of claim 17 is improper because the Office Action does not establish a *prima facie* rejection for claim 17. In order to establish a *prima facie* rejection of a claim under 35 U.S.C. 103, the Office Action must present a clear articulation of the

reason why the claimed invention would have been obvious. MPEP 2142 (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. __ (2007)). The analysis must be made explicit. *Id.* Additionally, rejections based on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

Here, the Office Action fails to explain why the limitations previously recited in claim 17 (now recited in claim 1) would have been obvious because the Office Action does not acknowledge the actual language of claim 17. In particular, the Office Action fails to acknowledge that claim 17 previously recited “the monitoring circuit is further configured to generate a plurality of alert signals, including up to one alert signal for each address bit line and data bit line that is monitored, wherein the monitoring circuit further comprises logic gates to combine the plurality of alert signals into a single alert signal and to output the single alert signal” (emphasis added). In fact, the Office Action does not even make an assertion that the cited references might describe the recited logic gates, or that the indicated limitation might otherwise be obvious in light of the cited references. It appears that this oversight in the Office Action may be a result of combining the rejections of claims 11 and 15-17 together, and only providing reasoning directed to some of the limitations of claims 11, 15, and 16. Nevertheless, claim 17 recites logic gates as a separate limitation that is not addressed in the reasoning used to reject claims 11, 15, and 16.

Therefore, the Office Action fails to establish a *prima facie* rejection for claim 17 as previously presented, as well as claim 1 as presented herein, because the Office Action does not assert or show how the cited references might teach logic gates in the specific arrangement recited in the language of the claim. Accordingly, Applicant respectfully submits that the rejection of claim 1 under 35 U.S.C. 103(a) should be withdrawn because the Office Action fails to establish a *prima facie* rejection for the language previously recited in claim 17 and currently recited in claim 1.

Independent Claim 10

Applicant respectfully asserts independent claim 10 is patentable over the cited references at least for similar reasons to those stated above in regard to the rejection of

independent claim 1. In particular, claim 10 recites “generating a plurality of alert signals, including up to one alert signal for each address bit line and data bit line that is monitored, if the deviation exceeds a predetermined value” and “combining the plurality of alert signals through logic gates into a single alert signal to output the single alert signal” (emphasis added).

Here, although the language of claim 10 differs from the language of claim 1, and the scope of claim 10 should be interpreted independently of claim 1, Applicant respectfully asserts that the remarks provided above in regard to the rejection of claim 1 also apply to the rejection of claim 10. Accordingly, Applicant respectfully asserts claim 10 is patentable over the cited references because the Office Action does not address the actual language of the claim and, hence, fails to establish a *prima facie* rejection based on obviousness.

Dependent Claims

Claims 2-9, 11-14, 16, and 18-20 depend from and incorporate all of the limitations of the corresponding independent claims 1 and 10. Applicant respectfully asserts claims 2-9, 11-14, 16, and 18-20 are allowable based on allowable base claims. Additionally, each of claims 2-9, 11-14, 16, and 18-20 may be allowable for further reasons.

CONCLUSION

Generally, in this Amendment and Response, Applicants have not raised all possible grounds for (a) traversing the rejections of the Action or (b) patentably distinguishing any new claims (i.e., over the Cited References or otherwise). Applicants however, reserve the right to explicate and expand on any ground already raised and/or to raise other grounds for traversing and/or for distinguishing, including, without limitation, by explaining and/or distinguishing the subject matter of the Application and/or any cited reference at a later time (e.g., in the event that this Application does not proceed to issue with the claims as herein amended, or in the context of a continuing application). Applicants submit that nothing herein is, or should be deemed to be, a disclaimer of any

rights, acquiescence in any rejection, or a waiver of any arguments that might have been raised but were not raised herein, or otherwise in the prosecution of this Application, whether as to the original claims or as to any of the new claims, or otherwise. Without limiting the generality of the foregoing, Applicants reserve the right to reintroduce one or more of the original claims in original form or otherwise so as to claim the subject matter of those claims, both/either at a later time in prosecuting this Application or in the context of a continuing application.

Applicant respectfully requests reconsideration of the claims in view of the proposed amendments and the remarks made herein. A notice of allowance is earnestly solicited.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **50-4019** pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account **50-4019** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted,

/mark a. wilson/

Date: April 27, 2009

Mark A. Wilson
Reg. No. 43,994

Wilson & Ham
PMB: 348
2530 Berryessa Road
San Jose, CA 95132
Phone: (925) 249-1300
Fax: (925) 249-0111